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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/897,226

07/02/2001

Kevin P. McAuliffe

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11/17/2006

AKERMAN SENTERFITT

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EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/897,226	MCAULIFFE ET AL.	
	Examiner	Art Unit	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 23-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/7/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 21, 22, 47, and 48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/29/2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 9, 10, 19, 20, 35, 36, 45, and 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.**

Regarding claims 9, 10, 19, 20, 35, 36, 45, and 46, the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how applicant intends to bias a straight comparison in favor on one party over the other.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 9, 10, 19, 20, 35, 36, 45, and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 9, 10, 19, 20, 35, 36, 45, and 46, these claims recite the limitation "said comparing step is biased in favor of". It is unclear how a straight comparison may be biased in favor of a merchant or a consumer. Examiner argues that a comparison is inherently in favor of the participant who finds the results of the comparison the most useful.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-20 and 23-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber (U.S. Patent No. 5,794,210).** Goldhaber teaches a system and method for e-commerce transaction negotiation that includes all of the limitations recited in the above claims.

Regarding claims 1, 11, 23-25, 27, and 37, Goldhaber teaches CPRs (software agent equipped with a consumer interest profile and specific buy/sell instructions) (Column 16, Lines 24-29 and Column 19, Lines 28-31), MBOs (Salesmen or bidding agents that have incentive or pricing information) (Column 4, Lines 58-59 and Column

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19, Lines 31-33), exchange of consumer information (upon viewing the advertisement, the consumer answers questions) (Column 16, Lines 10-15), and comparison to determine if an agreement can be made (once an advertisement is found to present to the consumer, the consumer views the advertisement and presents consumer information for payment) (Column 16, Lines 24-29). The selected good is considered to be the consumer's information commodity associated with bidding/asking price.

Regarding claims 2, 12, 28, and 38, Goldhaber teaches providing e-commerce transaction information to a processing system (Column 16, Lines 13-15).

Regarding claims 3-6, 13-16, 29-32, and 39-42, Goldhaber teaches the adjusting of pricing structures by bidding for consumer attention (Column 4, Lines 52-62). Counter offers are taught by attention bidding. Further, Goldhaber teaches buyer and seller agents as negotiating transactions (Column 8, Lines 26-28) and agent aided negotiation and bidding (Column 20, Line 51). Counter offers are inherent in negotiation situations.

Regarding claims 7, 8, 17, 18, 26, 33, 34, 43, and 44, Goldhaber uses CyberCoin, which is a cash equivalent. Before joining the system, it is inherent that the user will agree (by signing up) to the form of compensation.

Regarding claims 9, 10, 19, 20, 35, 36, 45, and 46, if the buyer in Goldhaber is more pleased with the results of a comparison than a seller, then there is considered to be a bias towards the buyer and vice versa.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to automated and computer-implemented negotiation systems and methods:

U.S. Patent No. 5,794,207 to Walker

U.S. Pub No. 2002/0178103 to Dan


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JEFFREY D. CARLSON
PRIMARY EXAMINER